

The reply filed on October 2, 2008 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): applicant's discussion of how the present claims distinguish over the prior art is inadequate. According to Rule 37 CFR 1.111, applicant is only entitled to reconsideration if the following requirements have been met, and the underlined and bolded portions of the rule have not been met by applicant's October 2, 2008 response.

In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to **every** ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the **specific distinctions** believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. **A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references** does not comply with the requirements of

this section.

(c) In amending in reply to a rejection of claims in an application or patent under reexamination, the applicant or patent owner **must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references** cited or the objections made. The applicant or patent owner **must also show how the amendments avoid such references or objections**.

Applicant's single page of remarks (page 11 of the October 2, 2008 response) to approximately seven pages of detailed rejections and objections set forth by the examiner is not adequate. Applicant's discussion is marginally adequate as to Karl, applicant apparently asserting Karl lacks a first heat storage device. Is that correct? If Karl lacks more than that, precisely what is missing from Karl in regards to claims 1-6 and 11? More problematic, applicant's response is completely inadequate as to discussing how newly amended claims (most specifically claims 1-6 and 11) define over JP 8-49934. Originally JP 8-49934 was used to reject claims 1, 5, 6 and 11 under 35 USC 102(b). In the October 2, 2008 response applicant simply moved to first heat storage limitation from claim 5 to claim 1 and asserts without any explanation at all that amended claim 1 defines over JP 8-49934. It is still a 35 USC 102(b) reference, isn't it? If not, why not? The examiner does not see how it fails to anticipate nor is there any discussion of claims 2-6 and 11 and how they define over JP 8-49934. The JP 8-

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49934 reference clearly discloses the first heat storage device "STR" and the heat exchanger HEX in Figure 1. Applicant's remarks with respect to JP 8-49934 amount to no more than a general allegation that the claims define a patentable invention without specifically pointing out **how** the language of the claims patentably distinguishes them from the JP 8-49934 reference (a response forbidden by Rule 111, reproduced above). Applicant has omitted any mention of the Likitcheva reference used to reject claim 4 and how the present claims define over it. Furthermore, applicant has not addressed the detailed 35 USC 112 rejections set forth in the previous office action except to make another general allegation that the newly amended claims avoid the problems pointed out by the examiner without stating **how or why** applicant believes this to be the case.

See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John K. Ford whose telephone number is 571-272-4911. The examiner can normally be reached on Mon.-Fri. 9-5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cheryl Tyler can be reached on 571-272-4834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John K. Ford/
Primary Examiner, Art Unit 3744